



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

8

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/042,488	03/16/98	EVANS	R SALK1520-2

STEPHEN E REITER
GRAY CARY WARE & FREIDENRICH
4365 EXECUTIVE DRIVE
SUITE 1600
SAN DIEGO CA 92121

HM22/0116

EXAMINER

KAUSHAL, S

ART UNIT	PAPER NUMBER
----------	--------------

1633

14

DATE MAILED:

01/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/042,488

Applicant(s)

Evans et al

Examiner

SUMESH KAUSHAL

Group Art Unit

1633



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires _____ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Dec 14, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☒ will be entered upon filing of a Notice of Appeal ~~and an Appeal Brief~~.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

- ☒ Applicant's response ~~has~~ overcome the following rejection(s):

would be
Cancellation of claims 25-34 and 43-46 would overcome rejections under 35 USC 102 and 35USC 103.

- ☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Claims 1-24, 35-42 and 47-56 stands rejected under 35 USC 112(1) for reasons of record regarding enablement issues.

The amended claims read upon method of modulating expression of an exogenous gene in a "cell or host cell." **

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1-24, 35-42, and 47-56

- ☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

- ☒ Other ** which reads upon a cell present in a host or a subject. Therefore the method as claimed encompass a method for Gene Therapy, which is considered unpredictable for the reasons as set forth in the official action mailed on 10/12/00.

Deborah Clark
DEBORAH J. R. CLARK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600